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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,616	05/23/2001	Yasushi Kasajima	125A 3124	8821

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Koda & Androlia
Suite 1140
2029 Century Park East
Los Angeles, CA 90067-2983

EXAMINER

DALENCOURT, YVES

ART UNIT	PAPER NUMBER
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2157

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/863,616

Applicant(s)

KASAJIMA, YASUSHI

Examiner

Yves Dalencourt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is responsive to amendment filed on 01/04/2007.

Response to Amendment

The Examiner has acknowledged Applicant's response.

Response to Arguments

Applicant's arguments filed on 01/04/2007 have been fully considered but they are not persuasive.

Regarding Applicant's argument (page 10) that Ohgushi et al fail to disclose that the event specified is the generation and change of operation of a predetermined electronic device connected to a communication network so that the event is an object to be observed. The Examiner respectfully disagrees with Applicant's assertion because Ohgushi clearly discloses an event information monitor 105, which monitors event information stored in the event information storage device 220 and drives the corresponding event by driving the event driver 106 when the event satisfies an event drive condition. The event to be driven causes, for example, the E-mail automatic transmitter 107 to transmit the E-mail and causes a message display unit 109 to, for example, notify this to a user and drive an external program (col. 5, line 66 through col. 6, line 6).

In response to Applicant's argument (page 11, second paragraph) that the trigger condition in Tso et al. is not a transfer trigger as is required in the claimed invention.

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The Examiner contends that Tso does suggest in a broad sense such limitation (see col. 13, line 59 through col. 14, line 8; Tso discloses in block 103, for each user currently served by server A 17m schedule/resource controller 61 filters the traffic report InfoBites by using the criteria of the time of day and the location of each user to decide which InfoBites i.e., the parts of the InfoCast that pertain to the particular user). Applicant is kindly suggested to further define the term " transfer trigger " in the claims in order to overcome the Tso et al. prior art.

Regarding Applicant's argument (page 11, last paragraph), the Examiner maintains that Ohgushi et al in combination with Leonard do disclose the claimed language. Leonard provides software for managing electronic mail that enables the originator of the message to set, at the time that he or she composes the message, a self destruct date and time for that email, such that, upon that date and time, and independent, world wide, of the number and types of computers/software that may eventually interact with the message, the number of people who may eventually receive the message, or the number of handling incidents that may eventually impact the message, the message and all of its incarnations will vanish (see col. 9, lines 52 – 61).

In fact, it appears that Applicants are interpreting the claims very narrow without considering the broad teaching of the reference used in the rejection.

Applicants are reminded that the examiner is entitled to the broadest reasonable interpretation of the claims. The Applicants always have the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified.

In re Prater 162 USPQ 541, 550-51 (CCPA 1969).

In view of such, the rejection is maintained and repeated as follows:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 16, 18, 24, 26, 29, and 31 – 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Ohgushi et al (US 6,760,753; hereinafter Ohgushi).

Regarding claim 16, 18, 24, 26, 29, and 31 – 33, Ohgushi teaches a method for automatically transferring an electronic mail over a communication network (fig. 1), said method comprising the steps of: sending from a communication terminal unit an electronic mail in which a transfer trigger condition is written together with an address to be transferred according to predetermined rules to a communication server apparatus equipped on said communication network, said transfer trigger condition including as event information the occurrence and change of specified operation by an electronic apparatus connected to said communication network (fig. 2C; col. 1, lines 48 – 61; col. 5, lines 18 – 35), receiving and registering at said communication server apparatus said electronic mail (col. 5, lines 36 - 40), and watching at said communication server

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apparatus said event information over said communication network after registration of said electronic mail and transferring the electronic mail corresponding to the transfer trigger condition which has been met among the registered electronic mail to a communication terminal unit with the address to be transferred according to said trigger condition, when said transfer condition is met according to said event information (col. 2, lines 1 – 9; col. 5, lines 41 through col. 6, line 6). Claim 18 adds the limitation of allocating an individual identification code to said registered electronic mail, and sending said transfer trigger condition together with said allocated identification code to said electronic apparatus (col. 2, lines 19 – 53).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 17, 19, 22 – 23, 25, 27 – 28, 30, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohgushi et al (US 6,760,753; hereinafter Ohgushi) in view of Tso et al (US 6,047,327; hereinafter Tso).

Regarding claims 17, 19, 25, 27 - 28, and 30, Ohgushi teaches a method for automatically transferring an electronic mail over a communication network (fig. 1), said method comprising the steps of sending from a communication terminal unit an electronic mail in which a transfer trigger condition is written together with an address to be transferred according to predetermined rules to a communication server apparatus equipped on said communication network (fig. 2C; col. 1, lines 48 – 61; col. 5, lines 18 – 35), receiving and registering at said communication server apparatus said electronic mail (col. 5, lines 36 - 40), and watching at said communication server apparatus said event information over said communication network after registration of said electronic mail and automatically transferring the electronic mail corresponding to the transfer trigger condition which has been met to a communication terminal unit with the address to be transferred according to said trigger condition, when said transfer condition is met according to said event information (col. 5, lines 41 through col. 6, line 6).

Ohgushi teaches substantially all the limitations, including the idea of an e-mail automatic transmitter 107 to transmit the e-mail and causes a message display unit 109 to, for example, notify this to a user and drive an external program (col. 6, lines 3 – 6), but fails to specifically teach that said transfer trigger condition including as event

information arrival at specified place of a mobile electronic apparatus, the positional information of which can be obtained via said network.

However, Tso et al teaches an analogous system for distributing electronic information to a targeted group of users, which comprises an electronic information with a transfer trigger condition including as event information arrival at specified place of a mobile electronic apparatus, the positional information of which can be obtained via said network (col. 13, line 59 through col. 14, line 8; Tso discloses in block 103, for each user currently served by server A 17m schedule/resource controller 61 filters the traffic report InfoBites by using the criteria of the time of day and the location of each user to decide which InfoBites i.e., the parts of the InfoCast that pertain to the particular user).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Ohgushi by having an event information arrival at specified place of a mobile electronic apparatus, the positional information of which can be obtained via said network as a transfer trigger condition as evidenced by Tso for the purpose of allowing information providers and marketers to only send information to users who might be interested in that information the ability to "focus" the dissemination of information by allowing by having the ability of "focus" the dissemination of information, thereby reducing excessive waste of bandwidth and transmission capability.

Regarding claim 22, Ohgushi and Tso teach all the limitations in claim 17, and Ohgushi further teaches wherein said communication server apparatus or said automatic transfer and intermediary communication server apparatus sends a transfer

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completion notice to the communication terminal unit of the sender after completing transfer of the corresponding electronic mail according to said transfer trigger condition (col. 5, lines 13 – 18; col. 6, lines 55 - 61).

Regarding claim 23, Ohgushi and Tso teach all the limitations in claim 17, and Ohgushi further teaches wherein said communication server apparatus or said automatic transfer and intermediary communication server apparatus sends a transfer failure notice to the communication terminal unit of the sender when having failed to transfer the corresponding electronic mail to said communication terminal unit with the address to be transferred according to said transfer trigger condition (col. 8, lines 15 - 46).

Regarding claim 34, Ohgushi and Tso teach all the limitations in claim 17, and Ohgushi further teaches a specific template enable to be rewritable with said transfer trigger condition together with said address to be transferred, said communication network enabling a communication terminal unit accessing thereto to download said template over a communication network (see figs. 2 and 3).

Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohgushi et al (US 6,760,753; hereinafter Ohgushi) in view of Leonard et al (US 6,721,784; hereinafter Leonard).

Regarding claims 20 and 21, Ohgushi teaches substantially all the limitations of claim 16, but fails to specifically teach that said transfer trigger condition added an expiry date of automatic transferring for said registered electronic mail (claim 20); and wherein said electronic mail of which expiry date for automatic transferring has expired

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is transferred to the communication terminal unit with the address to be transferred or is erased, when the corresponding expiry date set in said transfer trigger condition expires.

However, Leonard teaches these concepts (see abstract, col. 1, line 47 through col. 9, line 9).

Thus, it would have been obvious to one of ordinary skill in the art to modify the teachings of Ohgushi by adding an expiry date of automatic transferring for said registered electronic mail for the purpose of allowing the originator of a message to control the lifespan or expiration of electronic messages.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

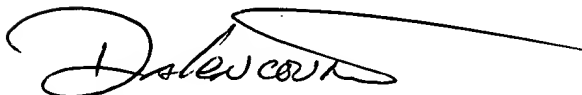
Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yves Dalencourt whose telephone number is (571) 272-3998. The examiner can normally be reached on M-TH 7:30AM - 6: 00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

March 30, 2007



YVES DALENCOURT
PRIMARY EXAMINER
TECHNOLOGY CENTER 2100